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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A. P.O. BOX 2938 MINNEAPOLIS, MN 55402				
			EXAMINER MENGISTU, AMARE	
			ART UNIT 2673	PAPER NUMBER 31

DATE MAILED: 07/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/211,942

Applicant(s)

LARSON ET AL.

Examiner

Amare Mengistu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 22,30.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. Claims 4 -27 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The specification as originally filed has failed to teach one skill in the art the following claimed limitations at the time of the invention:

In claim 4, lines 2-3, the recitation of the claim “a *mobile PDA having a wireless transmitter to transmit electronic voice signals to a personal computer*”;

In claims 17 and 22 lines 3-4 “ storing electronic voice signals on the PDA when *the PDA is located geographically away from the PC such that communication between the PDA and the PC is not possible*”

In claims 17 and 22, lines 6-7, “playing the stored electronic voice signals in place of displaying translated data on the PDA when *PDA is located geographically away from the PC such that communication between them is not possible*”, and;

In claims 17 and 22, lines 7-8, “wirelessly transmitting the electronic voice signals from the PDA to the PC, when the PDA is located

geographically such that communication between the PDA and the PC is possible”.

Thus, the specification as originally filed does not provide support for the above claims recitation.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 4-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. The recitation of claim 4, lines 3-4 “ ***a wireless receiver to receive translated voice information from the PC***” is not clear. It is not clear whose receiver the applicant is referring to?

Claim 4, lines 4 “ ***a touch screen display***” is not clear. It is not clear whose touch screen applicant is referring to? Who have a touch screen? The PC or the PDA?

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 4-8,10-12,14-15,18-21,23-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Stevens, III** (5,769,643) in view of **Ohashi** (5,581,783) and **Parvulescu et al** (5,724,410).

As to claims 4-8,10-12,14-15,18-21,23-27, **Stevens, III** (hereinafter **Stevens**) clearly teaches that a PDA system comprising: a wireless transmitter to transmit electronic voice signals to a PC (see, figs.3 (64,63) and 4; col.3, lines 8-19, lines 35-39); a wireless receiver to receive voice from the PC (see, fig.3 (64,67), col.3, lines 20-22); a touch screen display to enter information in response to physical contact and to visually display the translated voice information (fig.4 (54,56)); col.3, lines 8-22); a stylus having a first end to provide physical contact with the touch screen (fig.4 (55)). **Stevens** also teaches that the PC having a processor (fig.3 (42)); a wireless receiver and transmitter (fig.3 (30)) voice data and the stylus communicating with the PDA (fig.3 (55,62); fig.4 (55,12)).

Stevens did not explicitly teach the stylus having a microphone to receive and a transmitter to transmit a voice signal. However, **Ohashi clearly** states that it is well known for a stylus to have a microphone to receive a voice signal (figs.2, 7 (71)) and a transmitter to transmit the voice signal to the personal computer (same as PDA) (fig.2 (16, 18); col.2, lines 32-53,col.5, lines 38-43). **Ohashi** also teaches that the stylus including a microphone (fig.2 (71)); a switch

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for the microphone (fig.7 (14), col.6, lines 64- col.7, lines 1) and able to communicate with the personal computer with wire (see, fig.11). It is obvious that the stylus of **Ohashi** has to have a power supply in order to function or to provide the information to the PDA and personal computer.

Therefore, it would have been obvious to one skill in the art at the time of the invention was made to substitute the stylus of Stevens with the that of **Ohashi's** because this is an advancement for **Stevens's** stylus in order to capture an image and voice data with the stylus and transferring the information data into the PDA of **Stevens**.

Stevens as modified by **Ohashi** did not disclose translating voice data. The patent of **Parvulescu et al** is cited to teach that it is conventional for a computer system to convert voice into text and text into voice (see, Abstract, figs.5-7).

Therefore, it would have been obvious to one skill in the art at the time of the invention was made to have been motivated to use **Parvulescu's** voice to text converter into the system of Stevens, since this will allow the hearing impeard user to visually see the voice information on a display as text.

7. Claims 9,13,16-17,22 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Ohashi** (5,581,783) in view of **Stevens, III** (5,769,643) and **Parvulescu et al** (5,724,410).

As to claims 16-22, **Ohashi** discloses a stylus (fig.2) wirelessly transmitting electronic voice signals to a personal computer (PC) (fig.2 (16, 18,

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(a)); col.2, lines 32-53,col.5, lines 38-43); the PC receiving the electronic voice signals (col.2, lines 31-53,fig.3 (32,33 (a))).

Ohashi has failed to disclose that the PC to perform voice translation into text. The patent of **Parvulescu et al** is cited to teach that it is conventional for a computer system to convert voice into text and text into voice (see, Abstract, fig.5).

Therefore, it would have been obvious to one skill in the art at the time of the invention was made to have been motivated to use **Parvulescu's** voice to text converter into the system of Stevens, since this will allow the hearing disorders user to visually see the voice information on a display as text.

Ohashi as modified by **Parvulescu et al** failed to teach the wirelessly communication between PC and PDA.

Stevens teaches that it is conventional for PC and PDA to communicate wirelessly and displaying the message on the PDA (see, fig.3 col.3, lines 8-22).

Therefore, it would have been obvious to one skill in the art at the time of the invention was made to have been motivated to combine the wireless communication system of **Stevens** into the device of **Ohashi**, so that this will allow the user freely to move around without any restrictions.

Response to Arguments

8. Applicant's arguments filed on 4/12/2004 have been fully considered but they are not persuasive.

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On Page 20-21, Applicant argues that Ohashi "voice data" is used to describe recorded acoustic voice signals, as opposed to "translated voice data".

As to translating voice signals, **Parvulescu** is the one which is cited to teach.

Applicant also argues that the suggested combination of the references [**Stevens, Ohashi and Parvulescu**] is based upon hindsight and would not have been suggested but for Applicant's own disclosure. This is only Applicant's assertion and does not have any evidence.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

On page 21, Applicant also argues that **Parvulescu** does not appear to disclose transmitting electronic voice signals to a PC for translation into translated voice information by the received PC. **Stevens** is cited to teach a PDA system comprising having a wireless transmitter to transmit electronic voice signals to a PC (see, figs.3 (64,63) and 4; col.3, lines 8-19, lines 35-39) and

Parvulescu et al teaches that it is well known, for a computer system to convert voice into text and text into voice (see, Abstract, figs.5-7).

On page 22, here Applicant states that there is no motivation to combine **Stevens'** stylus with **Ohashi** since **Stevens** already has a microphone (fig.3 (67)). The Examiner strongly disagrees with Applicant's assertion, because the stylus of **Stevens** does not have a microphone. In fig.3 the microphone 67 belongs to the PDA (12) and not to the stylus (55). Furthermore, to combine reference there is no need to show reasonable expectation of success.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the combination of the references **Stevens, Ohashi and Parvulescu** is proper.

On page 23-24, Applicant argues that **Parvulescu** does not disclose or even suggest a PC having a processor, a speech recognition software to instruct the processor to translate electronic voice signals into translated voice data, a wireless receiver to receive the electronic voice signals from stylus and a wireless transmitter to transmit the translated voice data. However, **Stevens** is the one which is cited to teach a PC having a processor, **Ohashi** teaches a

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wireless receiver to receive the electronic voice signals from stylus and

Parvulescu suggests a speech recognition software to instruct the processor to translate electronic voice signals into translated voice data (see, fig.5). Thus, the combination of these references teaches Applicant's claimed invention.

Applicant argues the patentability of claims 4-27 by individually addressing the references used to reject the claims. Applicant cannot show nonobviousness by attacking the references individually where, as here, the rejection is based on a combination of reference. See In re Keller, 208 USPQ 871 (CCPA 1981).

In conclusion, **Stevens** discloses a wireless transmitting voice between PDA and PC. **Ohashi** clearly states that a stylus to have a microphone to receive a voice signal and a transmitter to transmit the voice signal to the personal computer and **Parvulescu** is only cited to teach the it is well known for PC to translating voice into text or vise versa. Thus, the combination of these references clearly teaches Applicant's claimed invention.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amare Mengistu whose telephone number is (703) 305-4880. The examiner can normally be reached on M-F, T-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bipin Shalwala can be reached on (703) 305-4938. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-9600.


Amare Mengistu
Primary Examiner
Art Unit 2673

*A.M
July 9, 2004